

REMARKS

Claims 1 and 23 have been amended. No new matter has been added. No claims have been cancelled, and no new claims have been added. Claims 1-6, 11-17, 22-28 and 33 are pending.

Claims 1 and 23 have been amended to include limitations recited in independent claim 12. As such, no new search is required.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Claim Rejections – Double Patenting

The office action rejected claims 1-6, 11-17, 22-28 and 33 as conflicting with claims 1-27 of Application No. 10/840,889 (“the child application”). The Examiner is requested to hold these rejections in abeyance pending an allowance of claims in this or the child application.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1, 2, 4-6, 11-13, 15-17, 22-24, 26-28 and 33 under 35 USC § 102(e) as anticipated by Yach (US 2002/0128036 A1). This rejection is respectfully traversed.

Claim 12

Independent claim 12 contains at least one limitation not disclosed, taught or suggested by Yach. Claim 12 recites:

“the object defines a function for sending a data trigger to a switch over a data network to initiate a telephone call over a telephone network between a **first telephone** corresponding to a previously stored telephone number **associated with the user of the client computer** and a **second telephone** corresponding to the identified telephone number” (emphasis added)

However, Yach nowhere discloses this limitation. Yach discloses a user (Person X) who sends an email (or similar message) from his computer to Person Y's mobile phone. After receiving the email, Person Y can select and call a phone number identified in that email (Person X for instance). Thus, in Yach, the telephone call is initiated from Person Y's mobile phone to Person X and person Y's mobile phone is one of the two telephones involved in the call. As such, only two devices are involved in the telephone calling method disclosed in Yach.

Claim 12 is distinguishable from Yach. In claim 12, the "client computer" identifies a telephone number and packages an object that defines a function for sending a data trigger to initiate a telephone call between "a first telephone corresponding to a previously stored telephone number associated with the user of the client computer" and a "second telephone corresponding to the identified telephone number". Claim 12 thus recites three devices, namely, the "client computer", the "first telephone" and the "second telephone".

In contrast, Yach, recites only two devices. In Yach, the phone call is activated at the first telephone, and the telephone used in the phone call is that same first telephone. Thus, only two phones or devices are disclosed in Yach. As such, claim 12 is patentable over Yach.

Similarly, claim 12 is also patentable over Chang (US 2003/0014754 A1) which is recited in a contemporaneously filed IDS. Chang discloses a set-top box (or communication appliance) connected to a television with a remote control, where the remote control can be used as a telephone (or a telephone can be used as a remote control). In Chang, when a user views an advertisement with a merchant's telephone number on the television, the user calls the merchant by pressing a single button on the remote control to initiate a call to the merchant via a set-top box. The remote control merely serves as an input device to the set-top box. The user then uses the remote control/set-top box combination as a phone to talk to the merchant. As such, Chang is similar to Yach in that the user activates the telephone call from a first device (namely, the remote control/set-top box combination), and further, proceeds to use that same telephone as one of two phones involved in the phone call.

Claim 12 is distinguishable from Chang. As discussed above, in claim 12, the “client computer” identifies a telephone number and packages an object that defines a function for sending a data trigger to initiate a telephone call between “a first telephone corresponding to a previously stored telephone number associated with the user of the client computer” and a “second telephone”.

Thus, while claim 12 recites three devices, Chang recites only two devices, namely the remote control (the first telephone), and the merchant’s phone (the second telephone). As such, claim 12 is patentable over Chang.

Claims 1 and 23

Independent claims 1 and 23 have been amended to include the limitation recited in claim 12. As such, all of the independent claims now recite similar features. Therefore, no new search is required.

Further, claims 1 and 23 are patentable over Yach and Chang for the same reasons claim 12 is patentable over Yach and Chang.

Further, by virtue of their dependency on claims 1, 12, and 23, claims 2, 4-6, 11, 13, 15-17, 22, 24, 26-28 and 33 are patentable over Yach for the same reasons claims 1, 12 and 23 are patentable over Yach.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 3, 14 and 25 under 35 USC § 103(a) as being unpatentable over Yach and Giordano (US 6,870,828). This rejection is respectfully traversed.

Claims 3, 14 and 25 are dependent on claims 1, 12, and 23 respectively. As such, these claims inherit the limitation of claims 1, 12, and 23 discussed above which is not disclosed, taught or suggested by Yach. Giordano does not cure this deficiency. Thus, by virtue of their dependency on claims 1, 12 and 23, claims 3, 14 and 25 are patentable over Yach and Giordano.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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